

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-30. By the present Response, Applicants have amended claims 1, 18-20, and 22-30. No claims are presently added or canceled. These amendments do not add any new matter. Upon entry of these amendments, claims 1-30 will remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

### **Objection to the Specification**

In the Office Action, the Examiner objected to the specification. Specifically, the Examiner stated, "The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed." Office Action, page 2. Accordingly, in the interest of furthering prosecution, Applicants presently amend the specification to include a new title, as set forth above. Specifically, as amended, the new title is "Method for Exchanging Information Between at Least Two Participants Via at Least One Intermediary to Limit Disclosure Between the Participants." In view of this amendment, Applicants respectfully request withdrawal of the objection to the Specification.

### **Claim Rejection Under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, the Examiner rejected claims 1-8 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, with regard to claim 1, the Examiner stated that "'the identity' has insufficient antecedent basis." Office Action, page 3. Applicants note that claims 2-8 were apparently rejected as being based on rejected independent claim 1.

Applicants do not agree with the Examiner's rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph. However, as a clarification, Applicants presently amend claim 1 to more clearly indicate that the plurality of intermediaries do not know which of the plurality of intermediaries is the selected intermediary.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-8 under 35 U.S.C. § 112, second paragraph. Further, Applicants request that the Examiner provide an indication of allowance for claims 1-8.

**Claim Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 23-25 and 28-30 under 35 U.S.C. § 102(e) as being anticipated by Labrou et al. (US Publication No. 2004/0030894; hereafter referred to as “the Labrou reference”). Applicants respectfully traverse this rejection.

Anticipation under 35 U.S.C. § 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). That is, to maintain a proper rejection under 35 U.S.C. § 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Indeed, the cited reference must not only disclose all of the recited features but must also disclose the part-to-part relationships between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Additionally, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner,

in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.*

Present embodiments are directed to combining information from one or more parties through an intermediary without facilitating access to the information (e.g., proprietary data and/or a proprietary program) held by each party. *See, e.g.,* Application, paragraphs 11-21. For example, a first party may own a proprietary program for analyzing data and a second party may own proprietary research data. *Id.* In such an example, the second party may wish to have the data analyzed by the first party's program but may be concerned about allowing the first party to access their proprietary data, thus, one or more intermediaries may be used to analyze the data with the proprietary program. *Id.* However, in such an example, because the parties may be concerned about providing their respective information to the intermediary or intermediaries, false (but plausible) information may also be supplied such that the intermediary or intermediaries would not be able to discern which set of data or which program is valid. *Id.* Accordingly, as amended, independent claim 23 recites, *inter alia*, “a party providing at least two sets of information to the intermediary, wherein the at least two sets include a set of *correct* information and a set of *incorrect information that is plausible*; a party receiving at least two sets of modified information from the intermediary... and wherein *the intermediary does not know which of the at least two sets of information is the correct information and does not know which of the at least two sets of modified information is based on the correct information.*” (Emphasis added).

In contrast, the Labrou reference merely appears to relate to confirming that certain data sets agree with one another. *See* Labrou et al., pages 3-4, para. [0052]-[0056]. Specifically, for example, the Labrou reference discloses an Agreement Verification Party (e.g., AVP 106) that determines whether data is consistent between an agreement message from a first Agreement Party (e.g., AP 101) and an agreement message from a second Agreement Party (e.g., AP 102). *Id.* In other words, the Labrou reference appears to relate to confirming that messages from two separate parties match. *Id.*

Applicants assert that the Labrou reference fails to disclose “a party providing ... a set of *correct* information and a set of *incorrect* information.” (Emphasis added). Indeed,

according to the Labrou reference, the two messages are each sent from a *different* party. *See, e.g.,* Labrou et al., page 3, para. [0052]. Thus, the Labrou reference does not disclose a single party that provides *two sets* of information. Further, assuming that a match is “correct” and a mismatch is “incorrect,” it seems that the Labrou reference merely discloses either having two messages that are correct or two messages that are incorrect. This is because, according to the Labrou reference, the messages are measured relative to one another. For example, the Labrou reference states that the messages “are checked to verify that the agreement data included in all received copies of the agreement is consistent.” Labrou et al., page 4, para. [0054]. Thus, according to the Labrou reference, it appears that if the two messages are the same, they are both consistent (which could potentially be described as being “correct”). Similarly, if the two messages are different, they are both inconsistent (which could potentially be described as being “incorrect”). Accordingly, Labrou fails to disclose a party providing both correct *and* incorrect information.

Additionally, the Labrou reference fails to disclose “the intermediary ... *does not know which of the at least two sets of modified information is based on the correct information,*” as recited in claim 23. (Emphasis added). First, as set forth above, it does not appear that the messages themselves are incorrect or correct when submitted to the Authentication and Verification Party (AVP). Rather, the messages are either consistent or inconsistent once received and compared with one another by the AVP. Further, even if consistency and inconsistency could be correlated with being correct and incorrect, the AVP *knows* whether the information it is supplying to the parties is based on consistent or inconsistent messages (or supplied data). Indeed, in contrast to the recitations of claim 23, the Labrou reference indicates that the AVP knows whether the modified information is based on inconsistent or consistent messages because the AVP communicates this information (the results of verification) to the parties. *See* Labrou et al., pages 3-4, para. [0054]-[0056]. Further, the messages submitted by the parties, as described by the Labrou reference, certainly do not disclose “incorrect information *that is plausible,*” as recited in claim 23. Indeed, the results from the AVP indicate that the messages are either valid (matching) or invalid (not matching). The Labrou reference does not appear to disclose that the AVP ever analyzes messages with contrasting data that could plausibly be consistent.

The Labrou reference also clearly fails to disclose “creating the incorrect information from the correct information,” and “creating the incorrect information as a plausible variation of the correct information,” as recited in claims 24 and 25, respectively. In accordance with present embodiments, correct information may be adjusted to be incorrect in order to mislead the intermediary, and, thus, prevent the intermediary from knowing what data is correct and what data is incorrect. According to the Labrou reference, data from a particular party would merely be consistent or inconsistent with the data from another party once it was compared to the data from the other party. Thus, it is unclear how a party could create incorrect information from correct information. Further, since the messages are either consistent or inconsistent, it is unclear how the messages could be incorrect *and plausible*. Additionally, Applicants remind that Examiner that, in order to rely upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied reference.

In view of the arguments set forth above, Applicants respectfully request that the Examiner withdraw the rejection of claims 23-25 and 28-30 under 35 U.S.C. § 102(e). Further, Applicants request that the Examiner provide an indication of allowance for claims 23-25 and 28-30.

**Claim Rejections Under 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected claims 1-3, 6-12, 15-18, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over the Labrou reference in view of Grundfest (U.S. Publication No. 2002/0165726; hereafter referred to as “the Grundfest reference”); claims 4, 5, 13, 14, 19, and 20 as being unpatentable over the Labrou reference and the Grundfest reference, in view of Munro, (U.S. Publication No. 2004/0002914; hereafter referred to as “the Munro reference”); and claims 26 and 27 as being unpatentable over the Labrou reference in view of Munro. Applicants respectfully traverse these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by

the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, it is not enough to show that all the elements exist in the prior art since a claimed invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). It is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* Specifically, there must be some articulated reasoning with a rational underpinning to support a conclusion of obviousness; a conclusory statement will not suffice. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Indeed, the factual inquiry determining whether to combine references must be thorough and searching, and it must be based on *objective evidence of record*. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); see M.P.E.P. § 2143.01. One important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at or after the time the invention was made. *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966).

In accordance with present embodiments, one of a plurality of intermediaries may be unknowingly selected to receive correct information, while the remaining intermediaries receive incorrect information. This may facilitate prevention of the disclosure of certain information (e.g., a proprietary program or proprietary data) by preventing the intermediaries from knowing whether the information they receive is correct. See Application, page 7, para. [0015]. Accordingly, amended independent claim 1 recites, *inter alia*, “[a] method ... comprising: providing *correct* information to the *selected intermediary*; providing *incorrect* information to each of the plurality of intermediaries who are not the selected intermediary ... and wherein the plurality of intermediaries do not know which of the plurality of intermediaries is the selected intermediary.” (Emphasis added). Independent claim 9 recites,

*inter alia*, “[a] method ... comprising: providing, by the first party, *correct* first party information to the *selected intermediary*; providing, by the second party, *correct* second party information to the *selected intermediary*; providing, by the first party, *incorrect* first party information to the *non-selected intermediary*; providing, by the second party, *incorrect* second party information to the *non-selected intermediary*...” (Emphasis added).

Independent claim 18, as amended, recites, *inter alia*, “[a] method of processing information, comprising: receiving, by a *selected intermediary*, *correct* information from a first party; receiving, by the *selected intermediary*, a *correct* program from a second party; *processing the correct information with the correct program* to produce intermediary information ... and wherein a plurality of additional *non-selected* intermediaries receive and process *incorrect* first party information in conjunction with an *incorrect* program.” (Emphasis added).

In contrast to claims 1, 9, and 18, the Labrou reference makes no distinction between a *selected* intermediary and any other intermediaries. The Examiner apparently suggested that the AVP is equivalent to the recited intermediaries. However, the AVP is not a *plurality* of intermediaries. Further, the AVP certainly cannot be *both* a selected intermediary and an unselected intermediary. Accordingly, the Labrou reference fails to disclose “providing correct information to the *selected intermediary*; providing incorrect information to each of the plurality of *intermediaries who are not the selected intermediary*,” as recited in claim 1. (Emphasis added). Similarly, the Labrou reference fails to disclose providing correct information and/or a correct program to “the selected intermediary” and providing incorrect information and/or a program to “the non-selected intermediaries,” as recited in claims 9 and 18. Additionally, it should be noted that, with regard to claim 18, none of the cited references appear to disclose providing a correct and/or incorrect “program” to an intermediary. Further, there would be no reason to combine any of the cited references to include providing a correct and/or incorrect *program*.

Further, to the extent that the AVP is “selected” according to the Labrou reference, the AVP receives *all* of the data, and there is no additional data that is provided to intermediaries that were not selected. Indeed, as admitted by the Examiner, the Labrou reference fails to disclose “providing the incorrect information to each of the plurality of intermediaries who are not the selected intermediary.” Office Action, page 5. Additionally, the Grundfest

reference, which the Examiner cited in addition to the Labrou reference, does not remedy this deficiency of the Labrou reference. Indeed, the Grundfest reference is merely directed to sharing contracts, and, as in the Labrou reference, there is no distinction between what type of information is provided to a *selected* intermediary and what type of data is provided to other intermediaries in the Grundfest reference. For example, neither of the references relied upon by the Examiner disclose anything about providing incorrect data to unselected intermediaries while providing correct information to a selected intermediary. Further, there is no apparent motivation in either the Labrou reference or the Grundfest reference for providing *incorrect* information to a particular type of intermediary. Indeed, it appears to providing incorrect information would merely cause problems. Thus, the references appear to actually teach away from the present claim features, which is an indicium of non-obviousness.

Additionally, with regard to claims 1, 9, and 18, according to the Labrou reference, it appears that the AVP receives information that does not have any designation as “correct” or “incorrect.” Rather, as discussed above, the Labrou reference merely appears to disclose comparing two messages and determining whether they match or not. Indeed, the messages are merely measured relative to one another. Thus, the Labrou reference does not even appear to disclose *providing* information to an intermediary that would be considered “correct” or “incorrect.” The messages cannot even be designated as valid (consistent) or invalid (inconsistent) until after they have been compared by the AVP. Further, even if one considered the messages disclosed in the Labrou reference to be “correct” or “incorrect,” the Labrou reference makes no distinction between submitting “correct” or “incorrect” information to a particular type of intermediary. In fact, the Labrou reference merely appears to disclose submitting *all* data to a single intermediary (e.g., the AVP). The Grundfest reference does not remedy these deficiencies of the Labrou reference.

Additionally, with regards to claim 1, the Labrou and the Grundfest references, whether considered separately or in a hypothetical combination, fail to disclose “the plurality of intermediaries do not know which of the plurality of intermediaries is the selected intermediary,” as recited in claim 23. (Emphasis added). As set forth above, neither of the cited references even makes a distinction between selected and non-selected intermediaries.



In view of the arguments set forth above, Applicants request that the Examiner withdraw the rejection of claims 1-3, 6-12, 15-18, 21, and 22 under 35 U.S.C. § 103(a). Further, Applicants request that the Examiner provide an indication of allowance for claims 1-3, 6-12, 15-18, 21, and 22.

**Payment of Fees and General Authorization for Extensions of Time**

No fees are believed to be due at this time. If any additional fees, including fees for extensions of time and other reasons, are deemed necessary to advance prosecution of the present application, at this or any other time, Applicants hereby authorize the Commissioner to charge such requisite fees to Deposit Account No. 08-2025; Order No. 200308584-1 (NUHP:0233/FLE/POW). In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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